

Attorney Docket No.: 47233-0050-00-US (221578)

Application No.: 10/519,979

Office Action Dated: October 30, 2008

Amendment and Reply Dated: March 31, 2009

## REMARKS

The amendments are made without prejudice or disclaimer of the canceled subject matter. Applicants reserve the right to file a continuing or divisional application on any subject matter canceled by way of amendment. Applicants respectfully request reconsideration and reexamination of the present application in light of the foregoing amendments and following remarks.

### **1. Status of the Claims**

The status of the claims following entry of the amendment is as follows:

**Claims canceled:** Claims 3, 5, 8, and 11-13

**Claims pending:** Claims 1-2, 4, 6-7, 9-10, and 14-36

**Claims allowed:** Claims 1-2, 17, 19, 22, and 24-30

**Claims rejected:** Claims 3-14, 18, 20-21, and 23

**Claims withdrawn:** Claims 15-16

**Claims added:** Claims 31-36

### **2. Support for the Amendments**

Claim 18 is amended to depend from the allowed pharmaceutical composition of claim 17. After amendment, claims 17 and 18 are directed to a pharmaceutical composition comprising the flavone C-glycoside derivative or salt thereof according to claim 1.

The pharmaceutical composition of claim 4 now depends on the allowed pharmaceutical composition of claim 25. Claims 4 and 25 are now directed to the pharmaceutical composition comprising the flavone C-glycoside derivative or salt thereof according to claim 2.

Claims 6 and 7 now depend from the allowed food composition of claim 19, which comprises the flavone C-glycoside derivative or salt thereof according to claim 1. Claims 20 and 21 now depend from the allowed food composition of claim 26, which comprises the flavone C-glycoside derivative or salt thereof according to claim 2. The word "composition" is added to claim 26 to clarify antecedent basis.

The cosmetics of claims 9 and 23 now depend from allowed cosmetic claims 22 and 27, respectively.

The aforementioned amendments merely change claim dependencies and thus do not enter impermissible new matter.

Claims 31-36 are directed to methods of using pharmaceutical compositions, food compositions, and cosmetics. The claims are supported throughout the specification as filed. *See, e.g.*, Specification, p. 5, lines 6-10; p. 7, line 17 through p. 8, line 13.

By the amendment, the claims are organized in the following categories, where claims are listed in their order of claim dependence and method claims are listed last:

	<b>Formula 1</b>	<b>Formula 2</b>
Compounds	Claims 1, 10, 29, and 15	Claims 2, 14, 30, and 16
Pharmaceutical compositions	Claims 17, 18, 31, and 24	Claims 25, 4, 34, and 28
Food compositions	Claims 19, 6, 7, and 32	Claims 26, 20, 21, and 35
Cosmetics	Claims 22, 9, and 33	Claims 27, 23, and 36

### **3. Restriction/Election**

New claims 31-36 are directed to non-elected subject matter. Applicants request examination on the merits of new claims 31-36, as methods of using an allowable product. *See MPEP § 806.05(h).* Applicants also request rejoinder and examination on the merits of withdrawn claims 15-16, which depend from allowable claims 1 and 2, respectively. *See Id.*

### **4. Acknowledgement of Information Disclosure Statement**

Applicants note with appreciation the acknowledgement of the Information Disclosure Statement filed July 9, 2008.

### **5. Objection to the Claims**

Claim 18 is objected to as duplicative of claim 4. Claim 18 is amended to depend from claim 17, and the objection accordingly may be withdrawn.

### **6. Rejection of the Claims Under 35 U.S.C. § 102(b)**

Claims 3-7, 10-12, 14, 17-18, and 20-21 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,409,692 (“Nakahara”).

The rejection of claims 3, 5, and 11-12 is mooted by the cancellation of the claims without prejudice or disclaimer. By the amendment, claims 4, 6, 7, 20, and 21 depend from, and incorporate all the limitations of, allowed claims 19, 25, or 26. The rejection against these claims accordingly may be withdrawn.

[A]

Applicants traverse the rejection of claims 10 and 14. To establish a *prima facie* case of anticipation, a single prior art reference must teach each and every element of the claimed invention, either explicitly or inherently. *Verdegaal Bros. v. Union Oil Co. Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Method claims 10 and 14 recite “adding” at least one flavone C-glycoside derivative or salt thereof according to claims 1 or 2, respectively, to a pharmaceutical composition, food composition, or cosmetic. The flavone C-glycoside derivatives or salts thereof according to claims 1 and 2 are “*isolated*.” Nakahara, however, fails to teach an isolated flavone C-glycoside derivative or salt thereof. Thus, Nakahara likewise fails to teach adding an isolated flavone C-glycoside derivative or salt thereof to a composition or cosmetic. Accordingly, Nakahara does not teach each and every element of the claimed methods. The rejection accordingly should be withdrawn.

[B]

Applicants traverse the rejection of claims 17 and 18. The Office maintains the rejection on the basis that the rejected claims do not recite an amount of a flavone C-glyco-side derivative or salt thereof. The Office reasons that any level of a flavone C-glycoside derivative or salt thereof would have therapeutic activity and thus would satisfy the claim element of a “therapeutic amount.” Claim 17, however, recites that the pharmaceutical composition contains at least about 0.001 weight % dry solids of one of the flavone C-glycoside derivative or salt thereof according to claim 1, and claim 18 now depends from claim 17. Accordingly, the present rejection should be withdrawn against claims 17 and 18 for the same reason that the Office withdrew the rejection against claims 1-2, 17, 19, 22, and 24-30.

**7. Rejection of the Claims Under 35 U.S.C. § 102(e)(1)**

Claims 3-14, 18, 20-21, and 23 are rejected under 35 U.S.C. § 102(e)(1) as allegedly anticipated by U.S. Published Application No. 2002/0136753 A1 (“Uehara”).

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The rejection of claims 3, 5, 8, and 11-13 is mooted by the cancellation of the claims without prejudice or disclaimer. By the amendment, claims 4, 6, 7, 9, 20-21, and 23 variously depend from, and incorporate all the limitations of, allowed claims 19, 22, 25, 26, or 27. The rejection against these claims accordingly may be withdrawn.

[A]

Applicants also traverse the rejection of claims 10 and 14 under § 102(e). To establish a *prima facie* case of anticipation, a single prior art reference must teach each and every element of the claimed invention, either explicitly or inherently. *Verdegaal Bros. v. Union Oil Co. Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Method claims 10 and 14 recite “adding” at least one flavone C-glycoside derivative or salt thereof according to claims 1 or 2, respectively, to a pharmaceutical composition, food composition, or cosmetic. The flavone C-glycoside derivatives or salts thereof according to claims 1 and 2 are “*isolated*.” Uehara, however, fails to teach an isolated flavone C-glycoside derivative or salt thereof. Thus, Uehara likewise fails to teach adding an isolated flavone C-glycoside derivative or salt thereof to a composition or cosmetic. Accordingly, Uehara does not teach each and every element of the claimed methods. The rejection accordingly should be withdrawn.

[B]

Applicants traverse the rejection of claim 18, as amended. Claim 18 now depends from, and incorporates all the limitations of, claim 17. Uehara fails to teach all the elements of claim 17, so it follows that Uehara likewise fails to teach all the elements of claim 18. The rejection against claim 18 accordingly should be withdrawn.

**8. Allowance of the Claims**

Applicants appreciate the indication that claims 1-2, 17, 19, and 22-30 are allowed.

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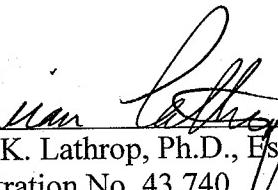
### **CONCLUSION**

In view of the above arguments and amendments to the claims, Applicants respectfully assert that the claims are condition for allowance and respectfully request a Notice of Allowance.

Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to charge or credit Deposit Account No. 50-0573 accordingly.

Respectfully submitted,

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